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Matthew A. Hayduk

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/955,510	Applicant(s) HAYDUK, MATTHEW A.	
	Examiner Melur Ramakrishnaiah	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, 7-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 5, 7-16, 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-5, 7-12, 16, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnunen et al. (US PAT: 6,813,501, filed 2-27-2001 hereinafter Kinnunen) in view of Rodriguez et al. (US 2002/0068599, filed 12-4-2000, hereinafter Rodriguez).

Regarding claim 1, Kinnunen discloses an application execution system, comprising: a position monitoring module (218, fig. 2, col. 8 lines 3-16), a mobile element (214, fig. 2) associated with a position capable of being monitored by the position monitoring module, the mobile element having memory including set of user service preferences (reads on 220, fig. 2) including first user preference, a service broadcaster (reads on 246, fig. 2) capable of being communicatively coupled to the mobile element and broadcasting second service preference to the mobile element based on the position of the mobile element, and a comparator module (not shown) included in the mobile element to compare the first and second service preferences, wherein the an application is downloaded to the memory when the first and second service are determined to be related by the comparator module (col. 3 lines 28-48; col. 10 lines 41-60; claims 14-16).

Kinnunen differs from claim 1 in that although he discloses comparing user service preferences in order to provide services (col. 3 lines 28-45), he does not specifically show: the service broadcaster including a first comparator module configured to filter the second service preference based on preferences received from the mobile terminal, and a second comparator module in the mobile element to compare and second preferences.

However, Rodriguez discloses system and method for dynamic local phone directory which discloses the following: the service broadcaster (for example mobile telephone company) including a first comparator module configured to filter the second service preference based on preferences received from the mobile terminal, and a second comparator module in the mobile element to compare and second preferences (last three lines of abstract; fig. 4, note: data filters 125 in fig. 1; fig. 4, first three lines of paragraph: 0054; and claims 2, 4).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kinnunen's system to provide for the following: the service broadcaster including a first comparator module configured to filter the second service preference based on preferences received from the mobile terminal, and a second comparator module in the mobile element to compare and second preferences as this arrangement would facilitate comparing/or filtering broadcast data at the mobile terminal or at a service broadcaster location in order to satisfy user preferences as taught by Rodriguez.

Regarding claims 2, 4-5, 7-12, Kinnunen further teaches the following: position-monitoring module (218, fig. 2) includes software program, a global positioning system receiver as shown in fig. 1 connected to (218, fig. 2) communicatively coupled to position monitoring module (col. 8 lines 1-16), mobile element (214, fig. 2) includes memory (this is implied by storing of user profile agent 220, service view agent 222, fig. 2), and wherein service broadcaster (reads on 246, fig. 2) includes application associated with the second service preference (col. 3 lines 28-48; claims 14-16), mobile element comprises personal internet client (222, fig. 2, col. 9 lines 36-49), mobile element comprises a cellular telephone (214, fig. 2), second service preference comprises hotel list file (col. 13 lines 36-42), plurality list files related to the set of user preferences is broadcast to the mobile element, plurality of list files is formatted as a selection list, selection list includes a selected number of items determined by the position (col. 9 lines 12-48).

Regarding claim 16, Kinnunen discloses an apparatus (fig. 2), comprising: a processor in (214, fig. 2), a memory coupled to the processor for receiving position of a mobile element (this is implied by location agent receiving position information from GPS etc, see fig. 2) and a first service preference (see user profile agent 220, fig. 2) associated with the mobile element (214, fig. 2), a memory coupled to the processor including the second service preference associated with user position, and an application associated with the second service preference, wherein the application is downloaded to the mobile element when the second service preference is determined

by the mobile element to be related to a first service preference stored in the mobile elements (col. 3 lines 29-48; claims 14-16).

Kinnunen differs from claim 16 in that although he discloses comparing user service preferences in order to provide services (col. 3 lines 28-45), he does not specifically show: a comparator module included in the apparatus to compare first and service preferences.

However, Rodriguez teaches the following: : a comparator module (reads on data filter 125, fig. 1) included in the apparatus to compare first and service preferences (note paragraph 0040 discusses data filters in order to meet user preferences).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kinnunen's system to provide for the following: a comparator module included in the apparatus to compare first and service preferences as this arrangement would facilitate to provision comparator/or filter in the apparatus such as mobile terminal in order to filter the data to suite user preferences in order to provide user applications services as taught by Rodriguez.

Regarding claims 18-19, Kinnunen further teaches the following: a memory for receiving a set of capabilities associated with the mobile element, application is downloaded to the mobile element (114, fig. 2) if the set of capabilities associated with the mobile terminal is not in accordance with a set of application requirements associated with the application (this is implied in as much as the reference teaches downloading applications that fits the profile of mobile terminal capabilities: col. 3 lines 30-48).

3. Claims 20-24 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnunen in view of Rodriguez and Loomis et al. (US PAT: 6,625,668, hereinafter Loomis).

Regarding claim 20, Kinnunen discloses a method of executing an application, comprising: determining a position of the mobile element, selecting a second service preference associated with the application according to the position and a first service preference retained in the mobile element, wherein the application is downloaded to the mobile element upon mobile element determining the first service preference is related to a second service preference (col. 3 lines 29-48; claims 14-16).

Kinnunen differs from claim 20 in that he does not specifically teach: position-monitoring module provided within the mobile element, service broadcaster to provide services and a comparator to determine service preferences.

However, Loomis discloses position reporting cellular telephone which teaches: position-monitoring module (14, fig. 1) provided within the mobile element (12, fig. 1, col. 2 lines 12-39); Rodriguez teaches: service broadcaster (reads on mobile telephone company) to provide services and a comparator (reads on data filter 125, fig. 1) to determine service preferences (note paragraph 0040 discusses data filters in order to meet user preferences).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kinnunen's system to provide for the following: position-monitoring module provided within the mobile element as this arrangement would provide one method, among many possible methods to determine the position of mobile

telephone user in order to provide desired services as taught by Loomis (col. 2 lines 35-41); service broadcaster to provide services and a comparator to determine service preferences as this arrangement would facilitate to provision comparator/or filter in the apparatus such as mobile terminal in order to filter the data to suite user preferences in order to provide services as taught by Rodriguez.

Regarding claims 21-24, Kinnunen further teaches the following: broadcasting the second service preference to the mobile element (114, fig. 2) requesting broadcast of the application, and broadcasting the application to the mobile element for downloading and execution by the mobile element (col. 3 lines 29-48; claims 14-16), storing the first service preference in the mobile element (see user profile agent 220, fig. 2), sending a set of capabilities associated with the mobile element (214, fig. 2) to a service broadcaster (such as location aware services 246, fig. 2), and refraining from broadcasting the application to the mobile terminal if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements associated with the application (this is implied in as much as the reference teaches downloading applications that fits the profile of mobile terminal capabilities: col. 3 lines 30-48), second service preference comprises a hotel list file (col. 13 lines 36-50).

Regarding claim 25, Kinnunen discloses a computer readable medium having program instructions stored thereon for implementing, when executed by digital processing device, a method for executing an application (col. 4 lines 23-42), the method comprising: determining position of a mobile terminal (col. 8 lines 9-16), selecting a second service preference associated with the application according to the

position and first service preference retained in the mobile element, wherein the application is downloaded to the mobile terminal (214, fig. 2) upon mobile element determining that the first service preference is related to a second service preference (col. 3 lines 29-48; claims 14-16).

Kinnunen differs from claim 25 in that he does not specifically teach: position-monitoring module provided within the mobile element, service broadcaster to provide services and a comparator to determine service preferences.

However, Loomis discloses position reporting cellular telephone which teaches: position-monitoring module (14, fig. 1) provided within the mobile element (12, fig. 1, col. 2 lines 12-39); Rodriguez teaches: service broadcaster (reads on mobile telephone company) to provide services and a comparator (reads on data filter 125, fig. 1) to determine service preferences (note paragraph 0040 discusses data filters in order to meet user preferences).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kinnunen's system to provide for the following: position-monitoring module provided within the mobile element as this arrangement would provide one method, among many possible methods to determine the position of mobile telephone user in order to provide desired services as taught by Loomis (col. 2 lines 35-41); service broadcaster to provide services and a comparator to determine service preferences as this arrangement would facilitate to provision comparator/or filter in the apparatus such as mobile terminal in order to filter the data to suite user preferences in order to provide services as taught by Rodriguez.

Regarding claims 26-27, Kinnunen further teaches the following: broadcasting the second service preference to the mobile element (214, fig. 2), requesting broadcast of the application, and broadcasting the application to the mobile element for downloading and execution by the mobile element (col. 3 lines 29-48; claims 14-16; col. 9 lines 12-49), sending set of capabilities associated with the mobile terminal to a service broadcaster, and refraining from broadcasting the application to the mobile element if the set of capabilities associated with the mobile element is not in accordance with a set of application requirements associated with the application (this is implied in as much as the reference teaches downloading applications that fits the profile of mobile terminal capabilities: col. 3 lines 30-48).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 13-15 are rejected under 35 U.S.C 102(e) as being anticipated by Kinnunen et al. (US PAT: 6,813,501, filed 2-27-2001 hereinafter Kinnunen).

Regarding claim 13, Kinnunen discloses a mobile element, comprising: a position monitoring module (218, fig. 2) capable of monitoring a position associated with the mobile element (214, fig. 2, col. 8 lines 3-16), a first memory including a first service

preference (this is implied by storage of user profile agent 220, fig. 2) , the memory capable of receiving a second service preference determined by the position, a comparator module (not shown) communicatively coupled to the memory to compare the first and second service preferences (col. 3 lines 28-45).

Regarding claims 14-15, Kinnunen further teaches the following: a global positioning receiver communicatively coupled to the positioning module (reads on 218, col. 8 lines 9-16), service broadcaster includes an application associated with an application associated with the second service preferences, and wherein application is downloaded to the memory when the first and second service preferences are determined to be related by the comparator module (col. 3 lines 29-48; claims 14-16).

Response to Arguments

In view of amendments to the independent claims 1, 16, 20, 25, rejection of these claims is based on new references as set forth in the office action above and further applicant's arguments regarding these claims and their dependent claims are moot in view of new rejection set forth above.

Rejection of unamended independent claim 13 is maintained and response to applicants arguments regarding this are set forth here.

Rejection of claims 13-15 under 35 U.S.C 102(e) as being anticipated by Kinnunen et al. (US PAT: 6,813,501, filed 2-27-2001 hereinafter Kinnunen): regarding rejection of claim 13, Applicant alleges that Kinnunen does not teach: a comparator module communicatively coupled to the memory to compare the first and second preferences. Contrary applicants interpretation of Kinnunen reference, Kinnunen

teaches: the mobile terminal with memory storing user profiles as shown in fig. 1. he further teaches: the profiles may be used for comparison purposes. For example, service profiles may be compared against user and mobile terminal profiles for determining whether provision of services to such a mobile terminal is permitted or possible (col. 3 lines 37-45; claims 14-16). This clearly reads on applicant's claim limitation such as a comparator module communicatively coupled to the memory to compare the first and second preferences. Therefore rejection of claim 13 and its dependent claims 14-15 is maintained as set forth in the office action.


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614